

REMARKS

Claims 17, 23-27, and 30-32 are presently pending in the application. Claims 18-22 and 28-29 have been canceled. Reconsideration is respectfully requested.

Double Patenting

Claims 25-26 and 30-31 have been rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11-12 of copending application no. 11/374,720. Upon agreement of allowable subject matter with the Examiner, applicants will file a terminal disclaimer removing the double patenting rejection.

Rejections under 35 USC §102

Claim 23 has been rejected under 35 USC §102(b) as being anticipated by Bold et al. It is unclear to which Bold reference the Examiner is referring, but based on the compounds cited (see, e.g., page 20, lines 4-5 of WO 03/040102), it is presumed that the Bold reference is international application No. WO 03/040102, to Bold, Furet, and Manley.

In order for a reference to qualify as prior art under 35 USC 102 (b), it must have been patented, or described in a printed publication in this or a foreign country or in public use or on sale in this country more than one year prior to the date of application for patent in the United States. WO 03/040102 was published on 15 May 2003, which is not one year before the effective filing date of the present invention. The reference does not qualify as prior art under 35 U.S.C. 102(b). Withdrawal and reconsideration are respectfully requested.

Claims 23 and 25 have also been rejected under 35 USC §102(e) as being anticipated by Bold et al. Based on the compounds cited, it is presumed that this Bold reference is also international application No. WO 03/040102, to Bold, Furet, and Manley.

The present invention is to the same inventive entity, namely Bold, Furet, and Manley. The '102 Bold reference therefore does not qualify as a reference under 35 USC 102(e) as it is not an invention "by another." Withdrawal and reconsideration are respectfully requested.

Rejections under 35 USC §103

The Examiner has also rejected claims 17, 26, 27, and 30 under 35 USC 1§03 (a) as being obvious over Manley (reference O). It is believed that reference O refers to Canadian Patent No. 2,396,590, which is the Canadian national application of International application no. WO 01/55114 to Manley ('114 Manley).

More particularly, the Examiner states that "Manley ['114 Manley] teaches the compound as shown in Formula I, wherein n is 1, W is O, R1 is hydrogen, R2 is an aryl group which is unsubstituted or mono- or polysubstituted, R and R' are independently of each other hydrogen, X represents mono-heteroaryl group comprising one nitrogen atom, which group in each case are unsubstituted or mono- or polysubstituted, as well as pharmaceutical compositions containing these compounds."

The presently claimed compounds however do not fall within the generic scope as outlined by the Examiner, and shown in Manley '114 because applicants present claims list Z as CH, and therefore have a phenyl ring where Manley '114 requires a pyridinyl ring. The presently claimed invention is therefore not a species of the genus of Manley and the rejection is therefore improper. Withdrawal and reconsideration are requested.

Additionally, claims 17, 24, 26, 27, 30, and 31 have been rejected under 35 USC 1§03 (a) as being obvious over Manley (reference O) in view of Patani et al. The references fail to render the invention obvious for the same reason iterated above. Withdrawal and reconsideration of the rejection are respectfully requested.

Rejections under 35 USC §112

The Examiner has rejected claim 32 under 35 U.S.C 112 as being indefinite for failing to distinctly point out and claim the inventive subject matter. More particularly, the Examiner objects to the phrase, "if so desired." Applicants have amended the claims to remove the phrase. Withdrawal and reconsideration of the rejections is requested.

Should the Examiner have any questions, please contact the undersigned attorney.

Respectfully submitted,


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